

REMARKS

Claims 1, 2, and 5 – 34 are now pending in the application. Claims 1, 2, 6, 8, 13 - 15, and 20 are now amended. Claims 3, 4, and 23-27 are now cancelled. Claims 28-35 are now added. The new claims are fully supported by the application as filed and do not present new subject matter. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

ELECTION/RESTRICTION

Applicant maintains that consideration of all of the claims as filed will not place an undue burden on the Examiner. However, Applicant now cancels withdrawn Claims 3, 4, and 23-27 in order to expedite prosecution of the application. Applicant reserves the right to present these claims again in a related application.

REJECTION UNDER 35 U.S.C. § 102

Rejection Based On The Rehmann et al. Reference

Claims 1-2 and 6-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rehmann et al. (U.S. Pat. No. 5,540,697).

Amended Claim 1 recites “a rotatable torque transfer system to transfer rotational torque from a second axis to said first axis, said torque transfer system rotates independently of said graspable portion” and “wherein said prosthetic engaging portion is operable to at least one of engage and disengage the prosthetic via said torque transfer system.”

The Rehmann et al. reference appears to disclose a prosthetic installation tool 10 having an impacting rod 24 having a first end 68. Proximate the first end 68 appear to be engaging fingers 26. The engaging fingers 26 appear to engage rims or grooves 28 of an implant socket 20. The engaging fingers 26 are biased in the retracted position of Figure 3 by springs 34. An outer body 36 is slidably mounted about the rod 24. An inner surface 50 at a first end 52 of the outer body 36 is biased against a control surface 54 of the fingers 26 to retain the fingers in the extended position of Figure 2 in which the fingers engage grooves in the implant 20 to retain the implant. Actuation of a handle 58 of a release means 40 causes the outer body 36 to slide away from the engaging fingers 26, as illustrated in Figure 3, to cause the fingers to revert to their biased position and permit separation of the implant from the installation tool.

The fingers pivot to engage and disengage the implant in response to pivoting actuation of the handle 58. In a voice message left for Applicant's representative Brent G. Seitz, the Examiner seemed to assert that the release means 40 imparts a torque on the implant to engage and disengage the implant. Applicant respectfully disagrees with this assertion. As set forth above, the installation tool of the Rehmann et al. reference does not impart rotational torque on the implant to engage and disengage the implant the implant.

Moreover, the Rehmann et al. reference fails to disclose or suggest each and every feature of Claim 1. For example, the Rehmann et al. reference fails to disclose or suggest "a rotatable torque transfer system to transfer rotational torque from a second axis to said first axis, said torque transfer system rotates independently of said graspable portion" and "wherein said prosthetic engaging portion is operable to at least

one of engage and disengage the prosthetic via said torque transfer system." Therefore, the Rehmann et al. reference fails to anticipate or render obvious Claim 1. Further, the Rehmann et al. reference fails to anticipate or render obvious the combination of Claim 1 with its respective dependent claims. Applicant respectfully requests reconsideration and withdrawal of this Section 102 rejection.

Rejection Based On The Bertuch, Jr. Reference

Claims 13-18 and 20-22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bertuch, Jr. (U.S. Patent No. 4,305,394).

Claim 13 recites, in part, "a torque transfer system at least partially housed in said angled portion that rotates independently of said angled portion and transfers rotational torque to said implant engaging portion; wherein said torque transfer system is operable to torque said implant engaging portion to at least one of engage and disengage the implant."

The Bertuch, Jr. reference appears to disclose an acetabular cup positioning instrument. The instrument includes a flange 43 with a drive screw 35 (cable 97) extending through the flange 43. A ball 51 for positioning an acetabular cup 72 is mounted to an end of the drive screw 35. The drive screw 35 imparts translatory movement on the ball, but no rotational movement. Specifically, "...upon drive being imparted to drive screw 35, there will be translatory movement of ball 51 toward or away from flange 43 but without any rotation of ball 51." See Col. 4, lines 42 – 48. Similarly, the cable 97 imparts translatory movement of the ball 51, not rotational movement.

The Office Action alleges that the cable 97 is equivalent to the claimed torque transfer system. However, the cable 97 does not impart rotational torque on an implant engaging portion. The Bertuch, Jr. reference fails to disclose or suggest "a torque transfer system at least partially housed in said angled portion that rotates independently of said angled portion and transfers rotational torque to said implant engaging portion; wherein said torque transfer system is operable to torque said implant engaging portion to at least one of engage and disengage the implant," as set forth in Claim 13. Thus, the Bertuch, Jr. reference fails to anticipate or render obvious Claim 13. Further, the Bertuch, Jr. reference fails to anticipate or render obvious the combination of Claim 13 with the claims dependent therefrom. Applicant respectfully requests reconsideration and withdrawal of this Section 102 rejection.

REJECTION UNDER 35 U.S.C. § 103

Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Rehmann et al. in view of Rohr (U.S. Patent No. 5,431,657). Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Bertuch, Jr. in view of Rohr '657. Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Rehmann et al. in view of Roche (U.S. Patent No. 4,632,111). Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Bertuch, Jr. '394 in view of Rohr '657. These rejections are respectfully traversed.

The claims rejected under Section 103 are each dependent upon one of independent Claims 1 and 13. As set forth above, Claims 1 and 13 are not anticipated or obvious in light of the cited art. Therefore, the combination of the independent claims

with the claims dependent therefrom is also not anticipated or obvious in light of the cited art. Applicant respectfully requests reconsideration and withdrawal of this Section 103 rejection.

NEW CLAIMS

New Claims 28 – 34 are now added. The new claims are fully supported by the application as filed and do not present new subject matter. For example, support for new independent Claim 28 can be found at least Figures 1 and 8 and at paragraphs 33 – 35. Support for the new dependent claims can be found at least Figures 1 and 8 and at paragraphs 33 – 35 as well.

New Claim 28 is not anticipated or obvious in light of the cited art because the cited art fails to disclose or suggest each and every feature of new Claim 28. For example, the cited art fails to disclose or suggest at least the following features: “a clearance portion between said prosthetic holding portion and said graspable portion, said clearance portion extending along a second axis that is offset from said first axis to provide a user of said apparatus with a clear view of said prosthetic holding portion; and a rotational torque transfer system including a torque transferring portion at said prosthetic holding portion that rotates independently of said outer housing and a driving portion extending from said prosthetic holding portion to said clearance portion, said torque transferring portion is angled relative to said driving portion.”

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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